

48. (Amended) The method of Claim [46] 47 wherein the marker/reporter protein is a fluorescent protein and the marker/reporter protein measurement is fluorescence.

REMARKS

Claims 18, 39 and 48 have been amended to more clearly point out and distinctly claim that which Applicants regard as their invention and to correct a typographical error. Support for the amendment is found in the originally filed claims. No new matter has been introduced.

Responsive to the Restriction Requirement dated August 3, 2000, Applicants provisionally elect with traverse the claims of Group I (Claims 1-8, 17 and 22-24 drawn to a non-human transgenic mammal, progeny or embryo thereof).

Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the invention of Group II (Claims 9-16, drawn to a method of making a non-human transgenic mammal); Group III (Claim 18, drawn to an expression construct); Group IV (Claims 19-21 drawn to a method of measuring a cell population); Group V (Claims 25-36, drawn to a method of obtaining cells); Group VI (Claims 37-42 and 47, drawn to a method of screening compounds for promoting differentiation of stem and progenitor cells); and Group VII (Claims 43-46 and 48-50, drawn to a method of assessing a compound's toxicity to stem and progenitor cells). Applicants do not hereby abandon or waive any rights in the Group II (Claims 9-16), Group III (Claim 18), Group IV (Claims 19-21), Group V (Claims 25-36), Group VI (Claims 37-42 and 47) or Group VII (Claims 43-46 and 48-50) inventions.

At the onset, Applicants note that claims of Groups VI and VII are classified in the same class and subclass and include common and overlapping subject matter. Applicants respectfully request that claims of Groups VI (Claims 37-42 and 47) be combined with claims of Group VII (Claims 43-46 and 48-50).

Applicants traverse the restriction requirement for the reasons set forth in detail below.

The Examiner states that the inventions are distinct and "have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter,

and because each invention requires a separate, non-coextensive search". (Office Action, page 5.)

Applicants respectfully submits that the claims of Groups I, II, III, IV, V, VI and VII are neither independent nor distinct as is required by 37 C.F.R § 1.142. In particular, Applicants note that:

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition (MPEP § 806.04).

It is respectfully submitted that Claims 1-50 of the subject application define "the same essential characteristic of a *single* disclosed embodiment of an invention", *i.e.*, DNA comprising a regulatory sequence of a mammalian nestin and a gene coding for a marker/reporter protein, in particular a fluorescent protein. It is respectfully submitted also that "the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition".

Contrary to the Examiner's position, Applicants respectfully submit that the inventions embraced by the claims classified in Groups I-VII are not divergent but embrace common and overlapping subject matter. For example, Claim 17 (Group I) includes all the elements of independent Claim 9 (Group II) and Claims 22-24 (Group I) include all the elements of independent Claim 19 (Group IV). Similarly, as amended, Claims 48-50 (Group VII) include all the elements of independent Claim 47 (Group VI). Contrary to the position taken by the Examiner, Applicants further submit that Claims in Groups V, VI and VII are classified in same class (class 435) and, in the case of Claims 37-50 (Groups VI and VII), also in the same subclass (subclass 7.21).

Applicants respectfully disagree with the Examiner regarding the need for separate, non-coextensive searches. Applicants note, for example, that a search directed to the subject matter of claims in Group I, specifically of Claim 17 and Claims 22-24, also includes searching the

subject matter of Groups II and IV, respectively. Similarly, a search directed to the subject matter of claims in Group VII, specifically Claims 48-50, also includes searching the subject matter of Group VI. Applicants note also that the subject matter of Groups V, VI and VII belongs in the same class. It is Applicants' position that claims in Groups V, VI and VII do not require separate, non-coextensive searches.

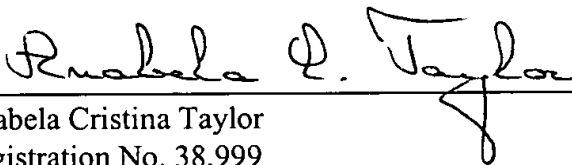
Applicants have discussed above the significant overlap and commonality of subject matter embraced by the claims in Groups I-VII. Applicants respectfully submit that search and examination of all the products and methods claimed can be made without serious burden and note that:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions (MPEP 803, page 800-3, column 2).

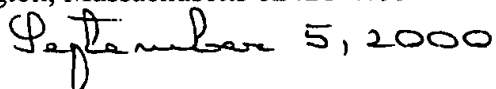
In view of the remarks presented above, reconsideration and withdrawal of the restriction requirement is respectfully requested. If the Examiner believes that a telephone conversation will expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (781) 861-6240.

Respectfully submitted,

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